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EXAMINER

JOHNS, CHRISTOPHER C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/817,597	Applicant(s) NAKADE ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20100102 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action, filed by Applicant on 17 September 2009. This case has had four (4) Requests for Continued Examination.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1-4, 7, 8, and 10-22 are pending.
5. Claims 1-4, 7, 8, and 10-22 have been examined.

Claim Rejections - 35 USC § 112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4, 7, 8, and 10-22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

8. Independent claim 1 recites, on lines 11-12, that the “position of the first user’s face” is extracted “according to luminance and color of the first image data. The specification discloses, at page 34, that “feature points such as the luminance changing points [and] the color changing points” are extracted; these points may actually be any area of a picture, including the user’s neck, shirt coloring, or even a non-human related region.

9. It appears that a region is selected using “luminance and color”, as claimed, but the position of the user’s face is not strictly determined using said luminance and color determinations. Rather, the position of the user’s face is apparently determined through database matching - see specification, page 34, lines 24-30. Lines 24-28 further support this rejection - “information stored [such as face shapes] are actively utilized by the candidate object detecting section, and objects such as those faces...are detected in the image signal which is composed of the feature points”.

10. In conclusion, while a region is detected by the color and luminance changes in an image, the face is not strictly detected using said changes.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4, 7, 8, 12-19, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 7,072,856 (“Nachom”) in view of U.S. Patent Application Publication 2001/0026351 (“Gao”).

13. As per claim 1, Nachom teaches:

14. connecting a plurality of communication terminals to each other and transmitting signals between said terminals (figures 1 and 2);

15. superposing first image data transmitted from a first communications terminal apparatus utilized by a first user with second image data of one or more products (figure 2, arrow between 24 and 26);

16. transmitting the superposed image to a user (figure 2; column 5, lines 10-33);

17. prescribed area in the first image data is determined based on...a usage of the one or more products (the popup in Nachom is sized according to the data enclosed in the popup, see figure 5, reference number 26. Further, it is inherent in the computing arts to create appropriately-sized windows).

18. transmitting advertisements to users of said terminals (figure 2; column 5, lines 10-33) and providing information to said users in response to a demand from said users (column 5, lines 33-43);
19. superposed image data (figure 2, reference number 26 - the data contained in that window is an image in and of itself).
20. displaying a transaction environment to the users (column 5, line 43 – column 6, line 6);
21. replacing an area of the first image data with the second image data and blending the data at a prescribed ratio (see column 5, lines 30-35 – “Information may be presented in the form of a pop-up screen or an embedded hyperlink”. Using a pop-up screen is a method that replaces a prescribed area of the first image data (the original webpage, figure 2, reference number 20) with second image data);
22. sending the superposed image based on the first user (advertiser) and a second user (consumer) (column 5, line 10 – column 6, line 44);
23. transmitting data over the Internet (column 4, lines 50-61), therefore transmitting data and signals that the Internet typically supports – such as the JPEG, GIF, MPEG, MP3 file formats (well-known to those skilled in the art at the time of the invention)
24. a user completing a transaction at a second site, accessed by clicking on said pop-up ads (see abstract; figure 2, reference numbers 34-40-44, 50, 52).
25. Nachom does not explicitly disclose:
26. extracting at least a position of the first user’s face as feature points from the first image according to luminance and color of the first image data;

27. prescribed area in the first image data is determined based on feature points of the first image data.

28. Gao teaches:

29. extracting at least a position of the first user's face (figure 2) as feature points (figure 2, reference p1, p2) from the first image according to luminance and color of the first image data (¶62 - "second subsystem interfaces with the user to acquire a high resolution, full color digital photograph of the user's face");

30. prescribed area in the first image data is determined based on feature points of the first image data (¶21 - "simulate eyeglass frames and digitally superimpose such frames on a digital image of the customer").

31. Gao does this to simulate the use of eyeglasses or other frames (e.g. sunglasses), in order to create a mock-up of how a specific user would look wearing a specific pair of frames. Human beings are imaginative, and can easily imagine items in real-world use - however, simulating the use of a product in real life (e.g. glasses on a real human face) gives them a better idea of what something would look like.

32. This is done to create a more convenient system, whereby users can actually see how a particular pair of glasses would look on any person; this, in turn, creates a more profitable system, because users would be more likely to purchase and use a system that gives them a good idea of how glasses would look.

33. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Nachom the concept of superimposing data upon facial features as taught by Gao,

since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it creates a more profitable and convenient system.

34. Claim 14 is similar to claim 1, and is rejected for similar reasons.

35. As per claims 2-4, 7, 8, 12, 13, 15-19, and 22, Nachom in view of Gao discloses as above, and further discloses:

36. products (figure 1, reference 16) are selected by said first user (figure 7, “Select a frame...”);

37. image data includes an image from said first user (figure 7, “take photograph of face”);

38. image is superposed with second image data so that the second data has a relation (the glasses are related to the user);

39. so that said user uses the one or more products (the user “wearing” the glasses is him using the glasses).

40. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nachom in view of Gao, further in view of US Patent 5,721,827 (“Logan”).

41. As per claims 10, 11, 20, and 21, neither Nachom nor Gao, nor the combination of both references, explicitly teach compensating a user for viewing advertisements. Logan teaches

compensating a user for viewing an ad (see abstract). Logan also teaches targeting advertisements to users based on user preferences (column 9, line 12 – column 10, line 5).

42. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Nachom and Gao the concept of compensating users for advertisements as is done in Logan, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would provide a more successful system where more users will click advertisements (because of the obvious financial benefits).

Claim Interpretation

43. Applicants are reminded that should the prior art rejections noted above be overcome by amendment/argument, the claims are nevertheless replete with functional language. While there is nothing inherently wrong with functional language, this language does not ordinarily assist in overcoming the prior art. See MPEP §2114. Claims 1 and 14 are noted for their usage of the functional language “to generate” (e.g. claim 1, lines 7-10). It is believed that Applicants intend “to generate” to be recited in a positive fashion, as “to generate” is functional language (specifically, intended use language) and is therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing “to generate” where a positive recitation is desired. See MPEP §2114.

Response to Arguments

44. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

45. Applicant's amendment, filed on 17 September 2009, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

46. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

48. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621